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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,842	02/27/2002	Jonas Grina	1392/2/2	2780

22847 7590 09/29/2003

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EXAMINER

RAO, DEEPAK R

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 09/29/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/083,842

Applicant(s)
Grina

Examiner
Deepak Rao

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 5, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 ☒ are pending in the application.
- 4a) Of the above, claim(s) 8-10 and 15-28 ☒ are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-14 ☒ are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 8 6) ☐ Other:

Art Unit: 1624

DETAILED ACTION

Claims 1-28 are pending in this application.

Election/Restriction

Applicant's election without traverse of Group I (claims 1-14) in Paper No. 10 is acknowledged.

Claims 15-28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Election was made **without** traverse in Paper No. 10.

Applicant's election **without** traverse of the species of drawn to a compound of Formula I wherein:

R1 is C3-C8 branched chain alkyl;

R2 is unsubstituted phenyl;

R3 is unsubstituted pyridyl; and

R4 is hydrogen.

The elected species reads on claims 1-7 and 11-14

Applicant is reminded of the election of species guidelines provided in MPEP § 803.02, which are followed for examination. Portion from MPEP is provided here for convenience:

As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD or CE. The Markush-type claim would then be examined fully with respect to the

Art Unit: 1624

elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the merits on the elected claims would be final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

The elected species was not found in the prior art search and as per the guidelines above, the search was expanded to cover compounds of formula (I) for other values of **R1** and **R3**, while retaining the definitions of **R2** and **R4** as indicated above for the elected species, and art was found. As per the guidelines above, claims 8-10 drawn to compounds of formula II are additionally withdrawn from consideration pursuant to 37 CFR 1.142(b), as being drawn to non elected inventions.

Claim Rejections - 35 U.S.C. § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 1624

Claims 1-7 and 11-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

1. In claim 1, line 1, the phrase "A compound **comprising** ..." is open ended and is not permitted in a compound claim. 'Comprising' in a compound claim, leaves the claim open for the inclusion of unspecified groups and/or substituents. The use of the above phrase causes the claim to be broader than the invention. See *In re Fenton*, 451 F.2d 640, 171 USPQ 693 (CCPA 1971). Replacing the phrase with -- A compound of -- is suggested.
2. Claim 1 recites "A compound **and** the salts, stereoisomers, **and** tautomers thereof", which is confusing because it is not clear if 'a compound or the salt thereof' is claimed or 'a **mixture** of a compound and the salt, etc.' is claimed. Replacing "and" with -- or -- is suggested.
3. In claim 1, it is recited that "R3 and O in Formula I to form a lactone ring" which is confusing. In formula I, the oxygen is doubly bonded and therefore has satisfied valency. It is not clear how R3 can form a ring with 'O'. The specification does not provide any disclosure of such compounds.
4. Claim 3 recites the limitation "one of R2 and R3 is substituted with a substituent forming a cyclic structure on adjacent atoms of the aromatic ring" in lines 1-3. There is insufficient antecedent basis for this limitation in claim 1 on which claim 3 is dependent.

Art Unit: 1624

The substituent list provided for the aromatic rings of R2 and R3 in claim 1 does not include any group to fit in the above recitation.

5. Claim 4 recites the limitation "wherein the substituent is selected from the group consisting of 1,2-methylenedioxy and 1,2-difluoromethylenedioxy" in lines 1-3. There is insufficient antecedent basis for this limitation in claim 1 on which claim 4 is dependent (via claim 3). The substituent list provided for the aromatic rings of R2 and R3 in claim 1 does not include any group to fit in the above recitation.
6. Claim 5 recites the limitation "3,4-methoxydioxyphenyl" under the definition of R2 in line 3. There is insufficient antecedent basis for this limitation in claim 1 on which claim 5 is dependent. The substituent list provided for the aromatic rings of R2 in claim 1 does not include a '3,4-methoxydioxy'. Further, it is not clear how this group is structurally presented.
7. In claim 7, the term "halo" is defined to include "fluoro, chloro.... and combinations thereof" which is confusing. It is not clear how one 'halo' group can include combinations such as fluoro and chloro, etc. The claim will be clear if amended to delete "and combinations thereof".

Claims not addressed above are included in the rejection because they are dependent claims and do not resolve the above issues.

Art Unit: 1624

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ajello et al. CAPLUS Abstract 71:80881. The instant claims read on the reference disclosed compound, see the compound having RN 23689-37-4.

Allowable Subject Matter

Claims 2-4, 7 and 12-14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action, limited to the examined subgenus as indicated above and to include all of the limitations of the base claim and any intervening claims.

Receipt is acknowledged of the Information Disclosure Statement filed on March 3, 2003 and a copy is enclosed herewith.

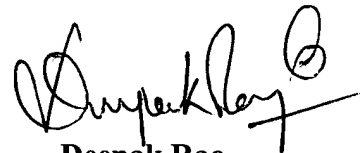
Art Unit: 1624

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (703) 305-1879. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Mukund Shah, can be reached on (703) 308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'Deepak Rao', with a stylized flourish at the end.

**Deepak Rao
Primary Examiner
Art Unit 1624**

September 27, 2003